

Serial No. 09/908,950 filed 7/19/01  
Response of 12/27/05 to Office Action of 6/27/05

### **Remarks**

Receipt is acknowledged of the Office Action of June 27, 2005 in the above-captioned matter. Reconsideration of the application and a three month extension of the time provided for response are respectfully requested. The Commissioner is hereby authorized to debit all amounts deemed required from Deposit Account No. 50-1604.

### **Rejections Under 35 U.S.C. §112**

In the Office Action, claims 17 and 53-56 were rejected under 35 U.S.C. §112, second paragraph. Further to the Examiner's recommendations, claims 53-56 have been amended to recite "The composition" instead of "The method", and claim 17 has been amended to recite "the pre-hybridized RNA-capture reagent complex". Both amendments correct minor typographical errors in the claim, and it is appreciated that the Examiner has brought this to our attention.

Accordingly, reconsideration and withdrawal of the §112 rejections is respectfully requested.

In addition to the foregoing, it is noted that the order of the clauses in claim 17 and several of the other claims has been modified herein for slightly better reading, without changing the scope of the claim.

### **Double Patenting Rejections**

In the Office Action, various claims were rejected under the judicially created doctrine of obviousness-type double patenting based on co-pending Application No. 09/802,162, Application No. 10/825,776, Application No. 10/234,069, and Application No. 10/050,088. Clarification is requested.

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One of the double patenting rejections was based on "Application 10/825,776 (Pub. No. 2005/0003366 A1)". However, Application 10/825,776 does not correspond to Pub. No. 2005/0003366 A1, it corresponds to Pub. No. 2005/0202449 A1. The cited Pub. No. 2005/0003366 in turn corresponds to Application No. 10/643,596. As both of those applications include Dr. Getts as an applicant, clarification is requested as to which application was intended so that counsel can properly respond.

Rejections Under 35 U.S.C. §102(e)

In the Office Action, various claims were rejected under 35 U.S.C. §102 based upon co-pending Application No. 09/802,162, Application No. 10/825,776, Application No. 10/234,069, and Application No. 10/050,088.

For each of these applications, the effective filing date being used for each §102(e) rejection is respectfully requested. In particular, it is unclear whether the rejections are being advanced based upon those applications' non-provisional filing dates, or based upon their priority dates.

For example, with respect to copending Application No. 10/234,069, it is noted that the application was filed on September 3, 2002 and claims priority to a provisional application filed August 31, 2001. The presently examined application was filed on July 19, 2001 (and also claims priority to a provisional application filed July 19, 2000). Thus, the '069 application cannot have an earlier effective filing date to the present application and cannot be cited under 35 U.S.C. §102(e).

Likewise, as set forth in the section above regarding the double patenting rejection, clarification is requested as to whether Application No. 10/825,776 was intended or Application No. 10/643,596.

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In view of the above, further information on these matters is requested so that counsel can more fully respond to the issues raised in the Office Action. Since clarification of the basis for various of the rejections is necessary to respond (and is also desirable so as to make a more complete determination of whether to amend, preserve, or cancel various claims), it is respectfully requested that the next Office Action be maintained as non-final.

Dated: December 27, 2005

Respectfully submitted,



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